

Attorney Docket No.: 42.P9889
Application No.: 09/750,532
Page 2

REMARKS

Claims 1-5, 7-15, 17-22, and 24-28 remain pending.

In the Office Action, the Examiner objected to the drawings; rejected claims 1-4, 8-14, 17-21, and 24-28 under 35 U.S.C. § 103(a) as being unpatentable over Reisman (U.S. Patent No. 6,594,692) in view of Swartz (U.S. Patent No. 6,445,694); rejected claims 5, 15, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Reisman in view of Swartz and further in view of Goldszmidt (U.S. Patent No. 6,195,680); and rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Reisman in view of Swartz and further in view of Bergler (U.S. Patent No. 5,572,675).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 1-4, 8-14, 17-21, and 24-28:

Applicants respectfully traverse the § 103(a) rejection of claims 1-4, 8-14, 17-21, and 24-28 over Reisman in view of Swartz. Independent claim 1 requires an application programming interface including, *inter alia*, "an extended application program interface to provide at least one of advanced function calls, properties, and callbacks beyond the common set." Independent claims 11 and 20 require a method and system including, *inter alia*, "providing at least one of

Attorney Docket No.: 42.P9889
Application No.: 09/750,532
Page 3

advanced function calls, properties, and callbacks beyond the common set.” The combination of Reisman and Swartz, even if it were proper, fails to teach or suggest the claimed API, method, and system.

Pages 3 and 5 of the Office Action allege that the third party API in col. 28, lines 58-65, of Reisman corresponds to the claimed extended application program interface. It is also alleged that col. 35, line 55 to col. 36, line 10 teaches or suggests the claimed “at least one of advanced function calls, properties, and callbacks beyond the common set.”

There is no teaching or suggestion, however, that the functionality in col. 35, line 55 to col. 36, line 10 of Reisman is performed by the third party APIs mentioned in col. 28. There is also no teaching or suggestion in col. 28 of Reisman that the taught “third-party API designed for use with a single specific online service” includes any of the claimed “advanced function calls, properties, and callbacks beyond the common set.”

Because the combination of Reisman and Swartz fails to teach or suggest all elements of claims 1, 11, and 20, a *prima facie* case of obviousness has not been established. The § 103(a) rejection of claims 1, 11, and 20 is improper and should be withdrawn. Claims 2-4, 8-10, 12-14, 17-19, 21, and 24-28 are allowable at least by virtue of their dependency from claims 1, 11, and 20.

A *prima facie* case of obviousness has not been established for claims 1-4, 8-14, 17-21, and 24-28, because there is no suggestion or motivation to combine the reference teachings as proposed. The proposed justification on page 3 of the Office Action, to “provide protocols suitable . . . to send voice and data between computers in real time,” is conclusory and factually

Attorney Docket No.: 42.P9889
Application No.: 09/750,532
Page 4

unsupported by citation to either reference or technical reasoning. In other words, no need or deficiency in Reisman has been shown or identified that would have motivated one of ordinary skill in the art to have transformed its call control protocols to the claimed IP telephony call control protocols. Without evidence of such motivating need or deficiency, a *prima facie* case of obviousness has not been established for claims 1-4, 8-14, 17-21, and 24-28, because no suggestion or motivation exists to combine the references as proposed.

Claims 5, 7, 15, and 22:

Regarding the rejections of claims rejected claims 5, 7, 15, and 22, the addition of Goldszmidt (claims 5, 15, and 22) and Bergler (claim 7) fails to cure the deficiencies noted in Reisman and Swartz noted above with respect to claims 1, 11, and 20.

Reconsideration and allowance of pending claims 1-5, 7-15, 17-22, and 24-28 is respectfully requested.

In the event that any outstanding matters remain in this application, Applicants request that the Examiner contact Alan Pedersen-Giles, attorney for Applicants, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess

Attorney Docket No.: 42.P9889

Application No.: 09/750,532

Page 5

fees to such deposit account.

Respectfully submitted,

Dated: December 20, 2004



Alan Pedersen-Giles

Registration No. 39,996

c/o Intel Americas
LF3
4030 Lafayette Center Drive
Chantilly, VA 20151
(703) 633-1061